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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------|
| 09/470,206 | 12/22/1999 | NAOKI TUCHITOI | 35.C14130 | 5891 |
| 5514 | 7590 | 04/13/2004 | EXAMINER | |
| FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | WALLERSON, MARK E | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2626 | |
| | | | DATE MAILED: 04/13/2004 | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/470,206

Applicant(s)

TUCHITOI ET AL.

Examiner

Mark E. Wallerson

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 25-31, 81-87, 137-143 and 193-199 is/are allowed.
- 6) ☐ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Continuation of Disposition of Claims: Claims pending in the application are 1-8,11-13,21,24-31,57-64,67-69,77,80-87,113-120,123-125,133,136-143,169-176,179-181,189 and 192-199.

Continuation of Disposition of Claims: Claims rejected are 1-8,11-13,21,24,57-64,67-69,77,80,113-120,123-125,133,136,169-176,179-181,189 and 192.

Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on 1/29/04.
2. This application has been reconsidered. Claims 1-8, 11-13, 21, 24-31, 57-64, 67-69, 77, 80-87, 113-120, 123-125, 136-143, 169-176, 179-181, 189, and 192-199 are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1, 57, 113, and 169 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 1, 57, 113, and 169, it is unclear to the Examiner whether “processing” of a print job as stated in 11 of claim 1 means “printing” or “analyzing”.

Claim 1 also states that the storing means stores “a print data portion that has already been analyzed by the generation means” (lines 15-16). However, lines 18-19 claim that the “generation means analyzes the print data of the interrupted print job stored in the storing means”. Accordingly, is the print data portion that has already been analyzed being analyzed a second time?

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1, 2, 3, 4, 7, 8, 11, 12, 13, 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoshida et al (Yoshida) (U.S. 6,130,757).

With respect to claims 1, 2, 3, 4, 7, 8, Yoshida discloses storing means (304) for storing print data; generating image data by analyzing the print data (column 7, line 64 to column 8, line 8); means for causing the image forming section to form an image based on the generated image data (column 8, lines 32-40); interrupt control means for, in response to an interrupt instruction identifying a print job, interrupting processing of a print job not identified in the interrupt instruction (the current job) and controlling the generation means to analyze print data of the print job identified in the interrupt instruction (column 18, lines 12-27); storing the print data of

the interrupted print job (column 18, lines 21-27), and analyzing the print data of the interrupted job after analysis of the interrupting job is completed (column 18, lines 27-47).

With regard to claim 11, Yoshida discloses the interrupt instruction is included in the identified job (column 18, lines 7-27).

With respect to claims 12 and 13, Yoshida discloses priority control means for controlling priority print processing such that the print data of a print job instructed for priority print is analyzed after the analysis of print data of another print job is completed (column 18, lines 7-47).

With regard to claim 21, Yoshida discloses not interrupting the processing of a current print job if interruption is not permitted (column 19, lines 40-53).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5, 6, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida in view of Sugiyama (U.S. 5,996,029).

With respect to claims 5 and 6, Yoshida differs from claims 5 and 6 in that he does not clearly disclose interrupting the processing of the current job by deleting the image data from the print data of the interrupted job.

Sugiyama discloses in response to an interrupt instruction for a print job from the external device deleting all generated print data (column 47, lines 42-43 and column 51, lines 34-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Yoshida to interrupt the processing of the current job by deleting the image data from the print data of the interrupted job. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Yoshida by the teaching of Sugiyama in order to improve the processing of the print jobs.

With respect to claim 24, Yoshida differs from claim 24 in that he does not clearly disclose setting means for setting whether the interrupt instruction can be used. Sugiyama discloses setting whether interrupt instruction can be used (column 42, lines 26-35).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Yoshida to set whether the interrupt instruction can be used. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Yoshida by the teaching of Sugiyama in order to give the user more control.

Claims 57-64, 67-69, 77, 80, 113-120, 123-125, 133, 136, 169-176, 179-181, 189, and 192 are the method, computer medium and computer program claims that pertain to the apparatus claims (claims 1-56), and are similarly rejected.

Allowable Subject Matter

9. Claims 25-31, 81-87, 137-143, and 193-199 are allowed.

Conclusion

10. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington, VA.
Sixth Floor (Receptionist)

MARK WALLERSON
PRIMARY EXAMINER

Mark Wallerson